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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/066,597	02/06/2002	Christopher S. Webb	MR2753-2/CIP	8411

4586 7590 01/07/2005

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EXAMINER
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JANVIER, JEAN D

ART UNIT	PAPER NUMBER
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3622

DATE MAILED: 01/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/066,597

Applicant(s)

WEBB ET AL

Examiner

Jean D Janvier

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-33 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-33 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_.

### **Response To Applicant's Amendments**

The Examiner approves the changes made to the claimed invention.

### **Response To Applicant's Arguments**

In general, Applicant argues that, in Burke's arrangement, the CCC is not for combining a buying power of a plurality of "additional amounts", but merely manages these "additional amounts" to be **further invested (on level 4) into individual accounts once reaching a predetermined threshold** and that Burke alone or in combination with Kalina, the secondary reference, **does not produce a merging (collective) account different from an individual account** and thus, the combination of Burke and Kalina teaches away from the claimed invention. Here, the Examiner completely and respectfully disagrees with the Applicant's findings. First of all, the merging account, as now recited in the claimed invention, performs the same function as the collective account and it is treated as the same. Second of all, the Applicant in his response fails to mention relevant embodiments of the Burke's reference, as included in the Office Action, that specifically address the current arguments presented. In fact, Burke discloses, in one embodiment, that the subscribers have full control over the excess payments tendered even when they use checks or credit/debit cards as payment instruments and the amount of excess payments or differences they want to donate, deposit, invest or simply put aside and receive a receipt at the end of each transaction showing the change or the amount donated, deposited or invested (figs. 5A-5B; col. 9: 30-34; col. 10: 63 to col. 10: 5; col. 10: 15-18). For example, a subscriber uses a check or credit/debit card during a shopping trip at a related POS to pay for a purchase in an amount equal to the exact value of the transaction, as far as the merchant

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is concerned. Here, a bank or credit/debit card company, handling the draft or the payment in a conventional manner for authorization and subsequent electronic transfer of funds to the retailer's or merchant's account, creates an excess payment called a **rounded amount by rounding-up the retail purchase value of the transaction to the highest dollar figure (or round the change in the retail price to the nearest dollar amount)**. The bank or the credit/debit card company drafts or charges or debits the subscriber's checking or credit/debit card for an amount equal to the **highest** dollar amount, that is the retail price plus the excess payment or rounded amount or portion, wherein the bank or the credit/debit card company manages and stores the subscriber's excess payments or rounded amounts or differences for subsequent electronic transfers to the subscriber's savings bank, or investment accounts at a mutual funds (predetermined single mutual fund or a mutual fund pre-selected by the customer) or annuities or bonds company or other security firm (**fig. 7-9C and 10A; col. 11: 24-46; col. 11: 59-67; col. 12: 7-16; col. 12: 50-59; col. 14: 11-31; col. 14: 62-64; col. 15: 14-25; col. 16: 5-10; col. 15: 44-49**). The subscriber, under the rounder system, updates an existing checking account and/or credit/debit card account and provides instructions to the bank related to the checking account and/or the credit/debit card issuer regarding the added rounded amount he wants to contribute during POS transactions (col. 12: 1-16). As seen above, there is threshold requirement per se before the customers' differences or rounded amounts are forwarded to an investment firm, such as a mutual fund company.

Third of all, **it is clearly understood in the financial industry** that a customer or investor can have someone else manage his money on his behalf by providing discretionary

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authority to a money manager or broker in an individual brokerage firm or other account managed for the specific investor or customer, or the customer or investor can invest in a vehicle such as a mutual fund (predetermined single mutual fund or a mutual fund pre-selected by the customer), a hedge fund or some other collective investment vehicle. To this end, the customer's differences or excess payments invested in investment vehicles, such as mutual funds (predetermined single mutual fund or a mutual fund pre-selected by the customer), are considered to be invested in a collective (merging) investment vehicle created at the mutual fund company and shared by a plurality of customers (collective investment), as implicitly supported by Burke.

Additionally, an investment vehicle such as a mutual fund is known in the art as a collective investment. In other words, all investments in a particular mutual fund are collectively invested therein. If the mutual fund is making money or being profitable, then the investors, individually identified by their respective individual or personal accounts, earn interest on their individual investments therein, based on the number of shares they individually own, although the investments are said to be collective. For example, if the company, related to the mutual fund, takes a portion of the money or differences invested therein to buy shares in IBM or General Motor (GM), then all the investors individually and collectively have interest or ownership in IBM and GM in accordance with the value of their investments (the number of shares they own). This is well known in the art and practiced in the financial industry for many years. And since Burke discloses investing the payors' or customers' differences in a mutual fund (insurance, securities...), then Burke implicitly supports the above well known disclosure and no further prosecution is necessary here.

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Moreover, the Kalina's reference was introduced just to show the step of providing the customer with online access to his account over the **Internet and for its overall teachings, but for disclosing a merging (collective) account, which is handled under the Burke's Patent.** Further, Burke clearly teaches giving the customer online access, in a LAN or WAN but over the Internet, to his account. Therefore, combining Burke with Kalina is deemed proper and such a combination does not teach away from the claimed invention, contrary to the Applicant's remarks.

Therefore, the Applicant's request for allowance or withdrawal of the last Office Action has been fully considered and respectfully denied in view of the foregoing response since the Applicant's arguments as herein presented are not plausible and thus, the last Office Action, as shown below, is hereby maintained and the current **Office Action has been made Final.**

### **DETAILED ACTION**

#### *Specification*

#### **Status of the claims**

Claims 1-33 are now pending in the Instant Application.

#### *Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Burke, US Patent 6, 112, 191A in view of Kalina, US Patent, 6, 243, 688.

As per claims 1-33, Burke, discloses an "open" POS network having a spending /saving system consisting of registered subscribers/payors, who tender payments exceeding the balance due or the transaction values during transactions at registered retailers' POS terminals, wherein the differences or excess funds between the received payments and the transaction values or retail prices are calculated or computed by the POS terminals or ECRs and deposited in an internal payor's or consumer's account maintained by merchants or retailers MC, related to the POS terminals, who in turn transfer the excess payments or collected differences to a single clearinghouse computer CCC, for further processing, on behalf of an identified payor or

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customer who identifies himself via a subscriber card swiped at the POS terminal or entering an account code therein. Further, the system allows each subscriber or SP the ability to make multiple deposits in various cross country locations at related and unrelated merchants' POS terminals, wherein the subscriber or payor can contribute as little as a **penny** in a transaction in 24 hour period. The storing of the differences or excess payments corresponding to the payor into the merchants' system databases or remote terminals can be conducted online or offline. At the completion of a specified period (periodically or weekly or daily) or when a certain threshold amount (like \$50.00) is reached, the total off-line transaction file, associated with the identified customer, stored in the merchant terminal internal databases is then batched online from each individual merchant's local database to the clearinghouse central computer CCC, **which transmits the collected differences or pennies via an EFT system to a PC related to at least one payor's selected provider account or PA, which can be banks, insurance companies, security firms, for deposits or savings and investments and the payor or the registered or enrolled customer can determine how to use the savings. Moreover, the PA, such a bank, a security firm or any other investment firm, will manage the subscriber's or SP's account in accordance with the subscriber's instructions.** The POS terminals at the merchants transfer the subscribers' excess payments or the differences or change due to the clearinghouse central computer or CCC in real-time via communication link CS. The subscribers can specify or have full control over the amount of excess payments they want to contribute or deposit into their accounts at one or more PAs, such banks, security firms, insurance companies or other investment entities (See abstract; col. 2: 45 to col. 3: 14; col. 3: 14-30; col. 3: 31-35; col. 3: 49-64; col. 4: 46-62; col. 4: 63 to col. 5: 40; col. 9: 1-15).



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Additionally, the subscribers can also access their accounts and withdraw money from deposited funds in real-time to pay for purchases during a transaction at participating merchants or MC if the funds or excess payments were transferred or deposited into a debit/checking or savings accounts at a bank. The MC POS allows the customer to view allocation or deposit information, change amount deposited, etc., via the POS terminal screen or ECR display. The CCC, acting as a clearinghouse, prints out periodic reports for interested parties, including subscribers, as needed. (Col.5: 42-53; col. 7: 52-59; col. 8: 15-23). It is further to be understood that a subscriber will receive periodic reports, such as monthly or quarterly statements, from a bank, insurance company, security firm or any other financial institution or investment firm where his excess funds or excess payments (or differences between the retail prices and the received payments tendered by the user or customer) were deposited or invested. **Further, the subscribers or investors have unlimited access to information regarding their savings accounts or investment accounts at the banks or investment firms where the excess payments or differences were deposited or invested (col. 8: 63-67).**

**In addition,** the CCC can execute a pay- out and transfers funds to different PAs involved and updates its databases or data banks accordingly, especially as funds are being received from the network POS terminals and transmitted on a regular basis to different PA accounts or PAs PCs (banks, security firms or insurance companies accounts or PCs- Col. 7: 63 to col. 8: 10). In an another embodiment, a PMS (provider management system) central computer used off-line or online is operable to open and close accounts, including the closing of subscribers' accounts opened at a savings bank or security firms where excess payments or differences were deposited or invested. When a bank account or investment account is closed,

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the subscriber initiating the closing or liquidating receives a refund in an amount equal to or less than the total amount currently deposited or invested depending upon whether an early closing penalty fee is imposed, as practice in the financial industry (col. 9: 6-9; col. 10: 55-64).

**Moreover, the subscribers have full control over the excess payments tendered even** when they use checks or credit/debit cards as payment instruments and the amount of excess payments or differences they want to donate, deposit, invest or simply put aside and receive a receipt at the end of each transaction showing the change or the amount donated, deposited or invested (figs. 5A-5B; col. 9: 30-34; col. 10: 63 to col. 10: 5; col. 10: 15-18). For example, a subscriber uses a check or credit/debit card during a shopping trip at a related POS to pay for a purchase in an amount equal to the exact value of the transaction, as far as the merchant is concerned. Here, a bank or credit/debit card company, handling the draft or the payment in a conventional manner for authorization and subsequent electronic transfer of funds to the retailer's or merchant's account, creates an excess payment called a rounded amount by rounding-up the retail purchase value of the transaction to the highest dollar figure (or round the change in the retail price to the nearest dollar amount). The bank or the credit/debit card company drafts or charges or debits the subscriber's checking or credit/debit card for an amount equal to the highest dollar amount, that is the retail price plus the excess payment or rounded amount or portion, wherein the bank or the credit/debit card company manages and stores the subscriber's excess payments or rounded amounts or differences for subsequent electronic transfers to the subscriber's savings bank, or investment accounts at a mutual funds (predetermined single mutual fund or a mutual fund pre-selected by the customer) or annuities or bonds company or other security firm (fig. 7-9C and 10A; col. 11: 24-46; col. 11: 59-67; col.

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12: 7-16; col. 12: 50-59; col. 14: 11-31; col. 14: 62-64; col. 15: 14-25; col. 16: 5-10; col. 15: 44-49). The subscriber, under the rounder system, updates an existing checking account and/or credit/debit card account and provides instructions to the bank related to the checking account and/or the credit/debit card issuer regarding the added rounded amount he wants to contribute during POS transactions (col. 12: 1-16).

In general, Burke discloses a system wherein a SP or customer can register or enroll into the savings program while at a participating merchant's POS during a transaction. First, the SP, before becoming a subscriber, registers with the clearinghouse central computer CCC over a communication link or network. Subsequently, at the POS, the SP or customer will sign-up with a PA (Bank, investment firm, etc.), over the communication link or network, where the customer's differences received by the CCC from a plurality of merchants are transferred from the CCC to the PA(s) (using EFT model). Here the communication link can be a LAN, WAN, etc. and the SP or now register customer or subscriber receives a magnetic card or an account number (identification means) that he can use to identify himself at the different POSes and make contributions to his account (col. 4: 11-14; col. 4: 42-52; Col. 10: 25-45; figs 6A-6C).

It is expected that the periodic statement issued to the customer or payor (when the customer accesses his account), by the banks or investment firms, will show among other things the account number, investment vehicle purchased, price paid, the number of shares owned by the customer based on the current market, etc., as known in the art.

**Finally, it is clearly understood in the financial industry that a customer or investor can have someone else manage his money on his behalf by providing discretionary authority to a money manager or broker in an individual brokerage firm or other account**

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**managed for the specific investor or customer, or the customer or investor can invest in a vehicle such as a mutual fund (predetermined single mutual fund or a mutual fund pre-selected by the customer), a hedge fund or some other collective investment vehicle. To this end, the customer's differences or excess payments invested in investment vehicles, such as mutual funds (predetermined single mutual fund or a mutual fund pre-selected by the customer), are considered to be invested in a collective (merging) investment vehicle created at the mutual fund company and shared by a plurality of customers (collective investment), as implicitly supported by Burke.**

As per claims 1, 5, 13, 14, 17, 22, 25 and 30, although Burke teaches registering a customer to participate in the savings program and providing the registered customer with online access to his account through participating merchants' POS terminals linked to the clearinghouse central computer (CCC) and the PA (bank or investment firm) central computer over a communication link or network or WAN (col. 4: 11-14; col. 4: 42-52; Col. 10: 25-45; figs 6A-6C), however, Burke does not expressly disclose providing the customer with online access to his account over the Internet.

However, Kalina discloses a system for providing a computer system 20 of figs. 1-1 and 1-2 for interactive communication between at least one customer (a plurality of customers) and at least one seller or retailer or merchant 26 of fig. 1-1, wherein a customer visit the seller's web site and clicks on an object or interactive indicia or hyperlink representing a manufacturer credit card to link to the manufacturer's site where the customer can apply for the credit card, which

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allows him to earn credits for purchases made using the credit card at the seller's POS and wherein the earned credits are invested at an investment firm on behalf of the customer (fig. 2; col. 5: 7-26; col. 5: 66 to col. 6: 14). During a transaction via the Internet at the seller's website, a web page displays an icon or interactive indicia, indicative of the manufacturer's credit card or subject credit card or the credit card associated with purchase awards or incentives or credits given to a customer for sponsoring a merchant who accepts the said credit card at said web site or a web page of said at least one seller, thereby encouraging the customer to select and use the subject credit card, as opposed to a typical competitor's credit card, during the current transaction and receives award credits that will be invested on behalf of the customer (col. 5: 66 to col. 6: 14) and (col. 5: 61 to col. 6: 41).

Finally, enrolling a customer in a system so that the customer can become a registered member having a proper login name and password or any other account number (identifier) before the customer can gain online access to his bank accounts, investment accounts, etc. over the Internet is well established in the industry (no further disclosure is necessary here—"Official Notice").

Therefore, an ordinary skilled artisan would have been motivated at the time of the invention to incorporate the above disclosure into the Burke's system so as to display at a participating retailer's or seller's website or web page, associated with a POS, over the Internet an interactive indicia or icon, which indicates that the retailer is a participating retailer and wherein upon clicking on the displayed icon a customer can register to participate in the savings program and wherein during purchases made by the customer at the retailer's web site or off-

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line, the retail prices are rounded to the highest dollar figure and the differences or excess payments are forwarded to the customer's bank account or investment account where they are deposited or invested respectively and wherein the registered customer can access his bank account or investment account, associated with the transferred differences, at the bank or investment firm website over the Internet, thereby rendering the savings program more accessible to millions of customers, during 24 hours a day and seven days a week, who can not only register online independent of their geographical locations, but also make purchases on the Internet in the privacy of their homes while contributing funds to their savings account and/or investment account and while the retailer's or seller's bottom significantly increases as a result of a greater exposure.

### **Conclusion**

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

US Patent 5,297,026A to Hoffman discloses a system for promoting account activity in a credit card account by rewarding customers by providing a high rate of return to the customers for funds invested by the customers if the customers use a particular credit card in purchasing goods and/or services at specific retailers.

US Patent 5,991,736A to Ferguson discloses an incentive system in which a monetary award is made to a customer's retirement account as an incentive for the customer to participate in a transaction with a sponsor.

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US Patent 6, 164, 533 to Barton discloses a point-of-sale automatic savings program contribution system, wherein an identified user or account holder can contribute monies to a savings program, such as an IRA, at an investment firm upon making a purchase at a participating retailer's POS. Barton discloses a system having a service provider interface connected to an input device for identifying an account holder and for receiving a monetary amount from the account holder at the POS, for computing or calculating a value representative of a savings program contribution based on the monetary amount received from the account or card holder and wherein a savings program provider receives the savings program contribution amount from the service provider interface over a communication link to further contribute the savings amount to an investment account as selected by the identified account or card holder. In one specific embodiment, Barton discloses a method and system for automatically contributing funds to a savings program (See abstract).

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

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however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication from the Examiner should be directed to Jean D. Janvier, whose telephone number is (703) 308-6287). The aforementioned can normally be reached Monday-Thursday from 10:00AM to 6:00 PM EST. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's Supervisor, Mr. Eric W. Stamber, can be reached at (703) 305- 8469.

For information on the status of your case, please call the help desk at (703) 308-1113. Further, the following fax numbers can be used, if need be, by the Applicant(s):

After Final- 703-872-9327

Before Final -703-872-9326

Non-Official Draft- 703-746-7240

Customer Service- 703-872-9325

JDJ

12/28/04

Jean D. Janvier

Patent Examiner

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JEAN D. JANVIER  
PRIMARY EXAMINER

A handwritten signature in cursive script that reads "Janvier Jean Dero".